



PATENT
Attorney Docket No. 08048.0032

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Jean-Louis GUERET) Group Art Unit: 1611
)
Application No.: 09/779,095) Examiner: Isis A. D. GHALI
)
Filed: February 8, 2001) Confirmation No.: 1674
)
For: COMPOSITE STRUCTURE)
HAVING AN ADHESIVE MATRIX)
CONTAINING ONE OR MORE)
ACTIVE AGENTS)

Attention: Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

05/22/2008 JADD01 00000015 09779095
01 FC:1402 510.00 OP

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

In support of the Notice of Appeal filed December 21, 2007, and further to Rule 41.37, Appellant presents this brief. Regarding the appeal brief fee under 37 C.F.R. § 41.20(b)(2), please apply the \$500.00 fee payment previously submitted on August 28, 2006. Enclosed herewith is payment of \$10.00, which is the difference between the prior \$500.00 fee payment and the correct fee of \$510.00. (See MPEP § 1204.1.)

This Appeal Brief is being filed concurrently with a petition for a 3-month Extension of Time, and payment of the appropriate extension of time fee.

Adjustment date: 05/22/2008 JADD01
08/29/2006 JADD01 00000010 09779095
01 FC:1402 -500.00 OP

Application No.: 09/779,095
Attorney Docket No.: 08048.0032-00000

This Appeal responds to the June 22, 2007, final rejection of claims 1, 5-30, and 35-68. If any additional fees are required or if the enclosed payment is insufficient, Appellant requests that the required fees be charged to Deposit Account No. 06-0916.

Table of Contents

Real Party In Interest.....	5
Related Appeals and Interferences	6
Status Of Claims.....	7
Status Of Amendments.....	8
Summary of Claimed Subject Matter	9
Independent Claim 1	9
Independent Claim 27	9
Independent Claim 54	10
Independent Claim 55.....	11
Independent Claim 56.....	11
Independent Claim 61	12
Independent Claim 68.....	12
Grounds of Rejection.....	13
Argument.....	14
The rejection of claims 9 and 66-68 under 35 U.S.C. 112, first paragraph, should be reversed.....	14
The rejection of claims 14 and 36-40 under 35 U.S.C. 112, second paragraph, should be reversed.	17
The rejection of claims 1, 5-11, 14-18, 27, 36-42, 47-52, 54-57, 59, 60, and 65-68 under 35 U.S.C. § 103(a) should be reversed.....	20
Remarks Regarding Features Common to All of Independent Claims 1, 27, 54-56, 61, and 68	21

Remarks Regarding Features Particular to Claims 66-68	25
Additional Comments Regarding the § 103(a) Rejection of Independent Claims 1, 27, 54-56, 61, and 68	26
The rejection of claims 19-26, 28-30, 35, 45, 46, 53, and 58 under § 103(a) should be reversed.	26
The rejection of claims 43 and 44 under § 103(a) should be reversed.	27
The rejection of claims 12, 13, and 61-64 under § 103(a) should be reversed.	27
Conclusion.....	28
Claims Appendix to Appeal Brief Under Rule 41.37(c)(1)(viii)	29
Evidence Appendix to Appeal Brief Under Rule 41.37(c)(1)(ix)	40
Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x)	41

Real Party In Interest

L'OREAL is the real party in interest.

Related Appeals and Interferences

The Board of Patent Appeals and Interferences issued a Decision on Appeal mailed on May 2, 2008 (copy attached in the Related Proceedings Appendix) in U.S. Application No. 10/107,410 (Appeal 2008-0002). Application No. 10/107,410 was originally filed on March 28, 2002 and has the same inventor as the present application. In addition, claims of that application were cited in a prior provisional obviousness-type double patenting rejection in an Office Action dated July 20, 2005, in the present application. Neither the Appellant, Appellant's legal representative, nor assignee knows of any other prior or pending appeals, interferences, or judicial proceedings which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

Status Of Claims

Claims 1, 5-30, and 35-68 are pending in this application. Claims 2-4 and 31-34 have been canceled. Claims 1, 27, 54-56, 61, and 68 are independent. All of pending claims 1, 5-30, and 35-68 stand finally rejected. Each of the rejections applied to those claims is at issue in this appeal.

Application No.: 09/779,095
Attorney Docket No.: 08048.0032-00000

Status Of Amendments

No amendments have been filed subsequent to the final rejection.

Summary of Claimed Subject Matter

Independent Claim 1

The subject matter set forth in independent claim 1 relates to a composite structure (10) for treating, making up, and/or cleaning a surface region. Page 1, lines 3-5; Figs. 1-16.¹ The composite structure may include at least two non-adhesive layers (12, 13), at least one of the two non-adhesive layers being permeable to a solvent and configured to be placed into contact with the surface region. Page 7, lines 26-30; Page 10, line 36-Page 11, line 3. The composite structure may also include at least one adhesive matrix (11) between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being permanently bonded to the adhesive matrix, and the adhesive matrix containing at least one active agent that is soluble in the solvent. Page 7, lines 31-37. Further, the composite structure may be configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region. Page 8, lines 1-4.

Independent Claim 27

The subject matter set forth in independent claim 27 relates to a method of manufacturing a composite structure (10) for cleaning, treating, and/or making up a surface region. Page 1, lines 3-5; page 5, lines 35-37; Figs. 1-16. The method may include coating a first non-adhesive layer (12, 13) with an adhesive matrix (11) comprising a permanent adhesive, said adhesive matrix containing at least one active

¹ In this Summary of Claimed Subject Matter, references to the text of the specification and drawings are provided to identify exemplary disclosure of certain subject matter. Those identifications should not be construed as imparting any limitation upon the scope of the claims, and the identifications should not be considered to be necessarily exhaustive.

agent, the active agent being released when the composite structure is wetted by a solvent. Page 6, lines 1-7. The method may also include assembling together the coated first non-adhesive layer with a second non-adhesive layer such that the adhesive matrix is sandwiched between the first non-adhesive layer and the second non-adhesive layer and such that one of the first and second non-adhesive layers is configured to be placed into contact with the surface region. Page 6, lines 8-11. Further, the first non-adhesive layer and the second non-adhesive layer may be permanently bonded together by the adhesive matrix. Page 6, lines 11-12.

Independent Claim 54

The subject matter set forth in independent claim 54 relates to a composite structure (10) for treating, making up, and/or cleaning a surface region. Page 1, lines 3-5; Figs. 1-16. The composite structure may include at least two non-adhesive layers (12, 13), at least one of the two non-adhesive layers being permeable to a solvent. Page 7, lines 26-30; Page 10, line 36-Page 11, line 3. The composite structure may also include at least one adhesive matrix (11) between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in the solvent. Page 7, lines 31-37. In addition, the composite structure may be configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region. Page 8, lines 1-4. Further, the structure may be configured such that the adhesive matrix does not come into contact with the surface region. Page 8, lines 5-7.

Independent Claim 55

The subject matter set forth in independent claim 55 relates to a composite structure (10) for treating, making up, and/or cleaning a surface region. Page 1, lines 3-5; Figs. 1-16. The composite structure may include at least two non-adhesive layers (12, 13), at least one of the two non-adhesive layers being permeable to a solvent. Page 7, lines 26-30; Page 10, line 36-Page 11, line 3. The composite structure may also include at least one adhesive matrix (11) between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive. Page 7, lines 26-30 and 31. The two non-adhesive layers may be permanently bonded to the adhesive matrix and the adhesive matrix may contain at least one active agent that is soluble in the solvent. Page 7, lines 36-37. In addition, the composite structure may be configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region, wherein the composite structure does not adhere to the surface region before being wetted by the solvent. Page 7, line 36-page 8, line 4.

Independent Claim 56

The subject matter set forth in independent claim 56 relates to a composite structure (10) for treating, making up, and/or cleaning a surface region of the human body. Page 1, lines 3-5; Figs. 1-16. The composite structure may include at least two support layers (12, 13), at least one of the two support layers being permeable to a solvent, the support layers forming external faces of the structure. Page 7, lines 26-30. The composite structure may also include at least one adhesive matrix (11) between the two support layers, the two support layers being permanently bonded to the adhesive matrix. Page 7, lines 26-30 and 31. The adhesive matrix may contain at least one

active agent that is soluble in the solvent. Page 7, lines 36-37. Further, the composite structure may be configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region. Page 7, line 36-page 8, line 4.

Independent Claim 61

The subject matter set forth in independent claim 61 relates to a composite structure (10) for treating, making up, and/or cleaning a surface region of the human body. Page 1, lines 3-5; Figs. 1-16. The composite structure may include at least two support layers (12, 13) and at least one adhesive matrix (11) between the two support layers. Page 7, lines 26-28. The two support layers may be permanently bonded to the adhesive matrix. Page 7, line 31. In addition, the adhesive matrix may include magnetizable particles. Page 3, lines 27-28.

Independent Claim 68

The subject matter set forth in independent claim 61 relates to a composite structure (10) for treating, making up, and/or cleaning a surface region of the human body. Page 1, lines 3-5; Figs. 1-16. The composite structure may include at least two support layers (12, 13) and at least one adhesive matrix between the two support layers. Page 7, lines 26-28. The two support layers may be permanently bonded to the adhesive matrix. Page 7, line 31. In addition, the composite structure may have a substantially constant thickness. Figs. 1-10 and 16.

Grounds of Rejection

Claims 9 and 66-68 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Claims 14 and 36-40 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite.

Claims 1, 5-11, 14-18, 27, 36-42, 47-52, 54-57, 59, 60, and 65-68 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith, III (U.S. Patent No. 6,491,928; hereinafter "Smith").

Claims 19-26, 28-30, 35, 45, 46, 53, and 58 stand rejected under § 103(a) as being unpatentable over Smith in view of Kochinke (U.S. Patent No. 5,350,581; hereinafter "Kochinke").

Claims 43 and 44 stand rejected under § 103(a) as being unpatentable over Smith in view of Auguste et al. (U.S. Patent No. 6,338,839; hereinafter "Auguste").

Claims 12, 13, and 61-64 stand rejected under § 103(a) as being unpatentable over Smith in view of Yoko (JP 04108710; hereinafter "Yoko").

Argument

The rejection of claims 9 and 66-68 under 35 U.S.C. 112, first paragraph, should be reversed.

With regard to the rejection of claim 9 under 35 U.S.C. § 112, first paragraph, the final Office Action alleges a lack of written description, while the remarks regarding this allegation appear to set forth an argument regarding enablement. For example, the final Office Action alleges that

[t]he recitation of “freeze-dried substances” without any description of these substances and their correlation to the moisture absorbing compounds does not meet the written description requirement as one of ordinary skill in the art could not recognize or understand . . . what are the freeze dried materials that acts (sic) as moisture absorbing compounds.

Final Office Action at 4. The final Office Action further alleges that

[t]he expression could encompass myriad of freeze-dried substances and applicants claimed “freeze-dried substances” represents (sic) only an invitation to experiment regarding possible means.

Id.

As explained in MPEP § 2163.04, “a description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971).” MPEP § 2163.04 further states that “[t]he examiner . . . must have a reasonable basis to challenge the adequacy of the written description” and that “[t]he examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. Wertheim, 541 F.2d at 263, 191 USPQ at 97.”

Without question, the originally filed application evidences that Appellant had possession of the “freeze-dried substances” recitation in claim 9. For example, “freeze-dried substances” were recited in originally filed claim 9, and they were also mentioned in the specification at p. 3, line 1. One of ordinary skill in the art would recognize and understand the meaning of this subject matter.

Appellant respectfully submits that there is no reasonable basis to challenge the adequacy of the written description and that no further clarification and/or examples are required for one of ordinary skill in the art to understand the scope of the term “freeze-dried substances” in the context of moisture absorbing compounds used in adhesive matrices. The final Office Action asserts that “[n]owhere in the specification [has] applicant . . . disclosed freeze-dried substances that [would be] suitable as moisture absorbing agents.” Final Office Action at 5. Further, the final Office Action concludes that “[o]ne skilled in the art would not recognize the freeze-dried substances that can be used in the present invention as defined by the claims.” Id. However, the Examiner has failed to cite any evidence or provide anything beyond conjecture that attempts to support these allegations. Accordingly, the Examiner has not provided sufficient evidence to rebut the presumption that the written description is adequate. Thus, the § 112, first paragraph, rejection of claim 9 should be reversed.

With regard to the rejection of claims 66-68 under § 112, first paragraph, Appellant submits that recitations in claims 66-68 are adequately supported by the original disclosure, for example, in figures 1-11 and 14-16. The final Office Action asserts, at page 3, that there is “no disclosure whatsoever in the specification for ‘composite that has substantially constant thickness.’” In support of this conclusion, the

Examiner cites several passages in Appellant's specification, which describe exemplary embodiments of the disclosed composite having support layers that "can be of different thicknesses." Final Office Action at 3, citing Appellant's published application, paragraphs 0022, 0062, and 0085. In citing these portions of Appellant's specification, the Examiner is apparently attempting to suggest that the specification contains only disclosure of "different thicknesses" and not "substantially constant thickness," as claimed. These portions, however, specify that the support layers, not the composite structure as a whole, can have different thicknesses. As described in the specification at page 7, lines 26-28, "[the] composite structure 10 comprises a layer of adhesive matrix 11 sandwiched between two support layers 12 and 13." Thus, the support layers 12 and 13 are merely portions or subparts of the composite structure 10. Therefore, it is irrelevant whether support layer 12 has a different thickness than support layer 13, because the issue is whether there is support in the original disclosure for the recitations in claims 66-68 requiring that the "composite structure [not its subparts] has a substantially constant thickness."

Appellant respectfully submits that the original disclosure does, in fact, provide support for these claim features. As noted in MPEP § 2163.06, "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter." Emphasis added. Since Figures 1-11 and 14-16 clearly show a composite structure having a substantially constant thickness, the recitations in claims 66-68 are properly supported.

For at least these reasons, Appellant respectfully submits that the rejection of claims 9 and 66-68 under § 112, first paragraph, is improper and should be reversed.

The rejection of claims 14 and 36-40 under 35 U.S.C. 112, second paragraph, should be reversed.

Appellant respectfully submits that the rejection of claims 14 and 36-40 under 35 U.S.C. § 112, second paragraph, should be reversed. As stated in MPEP § 2173.02, “[t]he test for definiteness under 35 U.S.C. § 112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’ Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).” MPEP § 2173.02 further indicates that a claim is indefinite “[o]nly when a claim remains insolubly ambiguous without discernible meaning after all reasonable attempts at construction.” Emphasis added. MPEP § 2173.02 clarifies that, with regard to the requirement of definiteness under 35 U.S.C. § 112, second paragraph, “[t]he essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.”

In addition, as clearly set forth in MPEP § 2173.04, “[b]readth of a claim is not to be equated with indefiniteness.” MPEP § 2173.04 continues, “[i]f the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph.”

A claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004) (holding that the disputed claim term 'surrender value protected investment credits' which was not defined or used in the specification was discernible and hence not indefinite because "the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence").

MPEP § 2173.02, (Emphasis added).

Claim 14 was rejected because the recitation of "vinyl" allegedly does not "set forth the metes and bounds of the claim." Final Office Action at 6. The final Office Action apparently objects to the purported lack of further description and/or examples of applicable vinyl compounds. The final Office Action further alleges that the term "vinyl" is ambiguous because it is purportedly unclear whether the term "vinyl" is intended to define a "chemical vinyl group, monomer, polymer, copolymer, or vinyl compounds, etc." Final Office Action at 7.

Appellant submits that no further explanation is needed for one of ordinary skill in the art to understand the scope of claim 14. There is no ambiguity as to the meaning and scope of the term "vinyl" in the context of adhesive matrices. Claim 14 specifies that "the adhesive matrix comprises a[n] . . . adhesive comprising one of vinyl, PVA, PVP" (Emphasis added). Applicant respectfully submits that one of ordinary skill in the art would readily understand the scope of "vinyl" as a component of an adhesive. Moreover, the mere fact that Applicant has broadly used the term "vinyl" such that it has not been limited to one of a chemical group, monomer, polymer, copolymer, or compound, does not render the claim indefinite because, as noted above, breadth of a claim is not to be equated with indefiniteness.

Claims 36-40 were rejected under § 112, second paragraph, because the expressions “additional active agent configured to swell,” “additional active agent soluble in the solvent,” and “compounds configures [sic] to swell,” are allegedly not defined in the specification. Final Office Action at 6. To the contrary, for example, the discussion of an “additional active agent” is found in the specification at, for example, page 14, lines 22-32, which explains that, in some embodiments, the adhesive matrix may include more than one active agent. In addition, Appellant respectfully submits that the claim recitation of active agents “configured to swell when contacted by [a] solvent” would be understood by those having ordinary skill in the art. Further, Appellant respectfully submits that the solubility of the active agent in a solvent is explained sufficiently in the specification, such that no further explanation is necessary to clarify what is meant by “additional active agent soluble in the solvent.” See, e.g., page 1, line 25--page 2, line 22.

The final Office Action attempts to point out alleged inconsistencies between the specification and the claims by contrasting the uses of the terms “active agents” and “inert compounds.” Specifically, the final Office Action cites page 2, lines 17-21 of the specification, alleging that “the specification does not define the active agents such that the adhesive matrix loses cohesion on contact with the solvent, but inert compounds.” Final Office Action at 7. Contrary to this allegation, however, the specification does not conflict with the claims because page 2, lines 5-10 of the specification indicates that, “[i]n a particular embodiment, the adhesive matrix contains one or more active agents . . . in sufficient quantity for the matrix to lose its cohesion on contact with the solvent and to release the active agent(s).” Further, the passage cited by the final

Office Action (page 2, lines 17-21) states that “in a particular embodiment, as a variant or in addition, the adhesive matrix contains a filler of one or more substantially inert compounds” Emphasis added. Therefore, as noted above, the adhesive matrix of the present application, in some embodiments, may include either or both an active agent and/or a filler, each of which may contribute to the loss of cohesion of the matrix and consequent release of the active agent/filler. Accordingly, there is no ambiguity in claims 36-40 and, therefore, the rejection of these claims under § 112, second paragraph, should be withdrawn.

For at least the foregoing reasons, Appellant respectfully submits that there is no support for the Examiner’s rejection of claims 14 and 36-40 under § 112, second paragraph. Accordingly, Appellant respectfully requests that this rejection be reversed.

The rejection of claims 1, 5-11, 14-18, 27, 36-42, 47-52, 54-57, 59, 60, and 65-68 under 35 U.S.C. § 103(a) should be reversed.

The rejection of claims 1, 5-11, 14-18, 27, 36-42, 47-52, 54-57, 59, 60, and 65-68 under § 103(a), based on Smith, fails to establish a *prima facie* case of obviousness for at least the reason that Smith does not disclose or suggest all the recitations of independent claims 1, 27, 54-56, 61, and 68. In addition, with respect to the features of independent claims 1, 27, 54-56, 61, and 68 that are acknowledged by the Examiner to be lacking in Smith, the Examiner fails to provide a legally sufficient rationale as to why one of ordinary skill in the art would have found it obvious to modify Smith to include such features in the manner suggested by the Examiner.

Remarks Regarding Features Common to All of Independent Claims 1, 27, 54-56, 61, and 68

Appellant respectfully submits that Smith fails to disclose a composite structure including, among other things, "at least one adhesive matrix," as recited in each of independent claims 1, 54-56, 61, and 68. For substantially similar reasons, Appellant submits that Smith also fails to disclose a method of manufacturing a composite structure including, among other things, "coating a first non-adhesive layer with an adhesive matrix," as recited in independent claim 27. Emphasis added.

The final Office Action alleges that Smith discloses a "therapeutic agent comprised within [a] composition comprising adhesive material." Final Office Action at 8-9. This allegation, however, is inconsistent with the Office Action mailed May 19, 2004, which admitted that "Smith does not expressly teach that the cleansing composition is in the form of an adhesive matrix." May 19, 2004 Office Action at 3. Appellant respectfully submits that the May 19, 2004 Office Action was correct in its assessment that Smith does not teach an "adhesive matrix," as recited in independent claims 1, 27, 54-56, 61, and 68. The portion of Smith cited in the pending final Office Action as allegedly disclosing an adhesive matrix (col. 31, lines 21-25) does not disclose adhesive at all. Instead, this portion of Smith mentions a "coacervate forming composition," which is merely a material tending to form clusters or droplets.² Smith lacks any disclosure or suggestion that the "coacervate forming composition" is an adhesive matrix. Moreover, one of ordinary skill in the art would readily recognize that a

² Coacervate is defined as "a cluster of droplets separated out of a lyophilic colloid." The American Heritage® Dictionary of the English Language, Fourth Edition. Retrieved May 14, 2008, from Dictionary.com website:
<http://dictionary.reference.com/browse/coacervate>

“coacervate forming composition,” which tends to form clusters or droplets, cannot be equated with an adhesive matrix, which comprises a permanent adhesive and/or is permanently bonded to non-adhesive layers (a feature discussed in greater detail below), as required by independent claims 1, 27, 54-56, 61, and 68.

Accordingly, Appellant respectfully submits that Smith does not disclose or suggest “at least one adhesive matrix” or “coating a first non-adhesive layer with an adhesive matrix,” and that, therefore, Smith fails to disclose all the features of independent claims 1, 27, 54-56, 61, and 68. For at least these reasons, Appellant respectfully submits that the rejection of these claims under 35 U.S.C. § 103(a) should be reversed.

In addition, in the final Office Action, the Examiner acknowledges that Smith fails to teach that “the two non-adhesive substrates are bonded permanently by the middle layer.” Final Office Action at 9; emphasis added. The Examiner alleges, however, that Smith discloses that “the [alleged³] adhesive used by [Smith] in the middle layer comprises acrylic polymer and polyurethane that are claimed by Applicant as permanent adhesive in claim 14 (col. 32, lines 40-43; col. 37, lines [sic] col. 39, lines 16-17).” Final Office Action at 9. From this alleged disclosure in Smith, the Examiner concludes that “the middle layer disclosed by [Smith] that [allegedly] comprises adhesive including acrylic acid polymer or polyurethane polymers is expected to be able to permanently bond to the first and second non-adhesive substrates[.]” Final Office Action at 9-10. That is, the final Office Action attempts to remedy Smith’s acknowledged failure to disclose an “adhesive matrix” by alleging that components of

³ As discussed above, Smith does not disclose an adhesive, but rather a “coacervate forming material,” which is merely a material that tends to form clusters or droplets.

the purported adhesive material in Smith are claimed by Appellant as permanent adhesive.

Thus, the Examiner appears to be making an inherency based argument. In making this inherency based argument, the Examiner appears to be relying on rationale set forth in MPEP § 2112(III), which states that “a rejection under 35 U.S.C. 102/103 can be made when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic.” In other words, if a prior art product seems to be identical to the claimed article, then any claimed characteristic may be considered inherent to the prior art product, and thus, the prior art product may be considered to support an anticipation rejection under 35 U.S.C. § 102 and/or an obviousness rejection under 35 U.S.C. § 103.

This doctrine set forth in MPEP § 2112(III) is based on the general requirements for establishing inherency, particularly the requirement that any claimed subject matter not explicitly disclosed in the prior art be “necessarily present” therein. Specifically, MPEP § 2112(IV) explains that

[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Emphasis added.

As also explained in MPEP § 2112(IV), the “Examiner must provide rationale or evidence tending to show inherency.” In the present case, however, the Examiner’s inherency argument fails to meet this burden. In the final Office Action, the Examiner

apparently alleges that, although Smith is silent as to any permanent adhesive, the materials of Smith are purportedly the same as those disclosed by Appellant to be components of a permanent adhesive. However, as explained in detail below, there is no evidence supporting the Examiner's attempt to equate the substances disclosed in Smith with Appellant's claimed permanent adhesive.

In particular, the Examiner does not provide any rationale or evidence tending to show that the coacervate forming material of Smith, which is alleged by the Examiner to be a purportedly adhesive material, is necessarily a permanent adhesive, nor does the Examiner provide any explanation of why one of ordinary skill in the art would have purportedly found it obvious to modify the coacervate forming material in Smith into a permanent adhesive. Contrary to the Examiner's allegations in the final Office Action, the present application does NOT disclose that individual substances such as acrylic polymer and polyurethane are necessarily permanent adhesives. Rather, the present application discloses a permanent adhesive which can include acrylic polymer and polyurethane as possible components of the permanent adhesive.

Acrylic and polyurethane are broad categories of polymers, which include many different materials that have many varied properties. Adhesive materials are only one of many different forms of such materials. Numerous non-adhesive materials can include acrylic and/or polyurethane. Although Smith might mention acrylic and polyurethane, Smith provides no further details about the characteristics of any compositions that might include acrylic or polyurethane components. Without any such details, nothing supports the Examiner's attempt to equate the acrylic and/or polyurethane materials of

Smith with an adhesive matrix comprising an acrylic polymer or a polyurethane, as recited, for example, in claim 14.

Since Smith does not describe the acrylic or polyurethane as being part of an adhesive, Smith's mere mention of acrylic and polyurethane does not disclose an adhesive that would be expected to provide permanent adhesion. Therefore, Smith does not disclose or suggest, nor would it have been obvious to modify Smith to include, a permanent adhesive or an adhesive matrix permanently bonded to non-adhesive layers. For at least these additional reasons, the rejection of independent claims 1, 27, 54-56, 61, and 68 under § 103(a) should be reversed.

Remarks Regarding Features Particular to Claims 66-68

With regard to claims 66-68, the Examiner alleges that Smith "does not teach that the thickness of the article changes [and that], therefore, it is constant." Final Office Action at 10. However, figure 3 of Smith clearly shows the cross section of the disclosed article having tapered thickness toward both ends.

It is noteworthy that the final Office Action purportedly finds no description in the present application or Smith about the thickness of the respectively disclosed articles, yet reaches opposite conclusions about what the respective disclosures teach. Specifically, the final Office Action, in the portions dealing with the claims rejection under 35 U.S.C. §112, first paragraph, effectively finds that, absent a verbatim description in the present specification, there is purportedly no support for the claim recitations of a substantially constant thickness. Contrarily, with regard to Smith, the final Office Action concludes that, absent any teaching in Smith that the thickness varies, it must be constant. Regardless of this inconsistency, however, Appellant

respectfully submits that Smith clearly shows an article having a tapered cross-section, indicating that its thickness is not constant, as required by claims 66-68.

Accordingly, Smith fails to disclose or suggest all the features of claims 66-68. Thus, Appellant respectfully submits that, for at least this additional reason, the Examiner has failed to establish a *prima facie* case of obviousness and that, therefore, the rejection of claims 66-68 under § 103(a) should be reversed.

Additional Comments Regarding the § 103(a) Rejection of Independent Claims 1, 27, 54-56, 61, and 68

During a recent interview with the Examiner, Appellant's representative pointed out the numerous deficiencies of the Smith reference with respect to the pending claims. The Examiner responded by arguing that the claims are (allegedly) so broad that there must be prior art that anticipates or renders the claims obvious. The Examiner's argument, however, provides absolutely no support for the § 103(a) rejection based on Smith, which is the issue at hand. When Appellant's representative pointed this out to the Examiner and asked her to explain why she believed there must be some additional prior art, she could only repeat her argument that the claims are simply too broad.

Appellant respectfully submits that the rejections under 35 U.S.C. § 103(a) are not supported by the evidence of record. Accordingly, the § 103(a) rejection of independent claims 1, 27, 54-56, 61, and 68 should be reversed.

The rejection of claims 19-26, 28-30, 35, 45, 46, 53, and 58 under § 103(a) should be reversed.

With regard to the § 103(a) rejection of claims 19-26, 28-30, 35, 45, 46, 53, and 58 as being unpatentable over Smith in view of Kochinke, the final Office Action

acknowledges that Smith "does not teach more than one superimposed layers [sic] containing adhesive or pile of the article[.]" Office Action at 11. In an attempt to cure this acknowledged deficiency of Smith, the Office Action relies on Kochinke solely for an alleged disclosure of a multilayer device having "more than one therapeutic agent contained in different adhesive matrices." Id. However, Kochinke does not cure the deficiencies of Smith noted above with regard to independent claims 1, 27, and 56, from which claims 19-26, 28-30, 35, 45, 46, 53, and 58 respectively depend. For at least this reason, the § 103(a) rejection of claims 19-26, 28-30, 35, 45, 46, 53, and 58 should be reversed.

The rejection of claims 43 and 44 under § 103(a) should be reversed.

With regard to the § 103(a) rejection of claims 43 and 44 as being unpatentable over Smith in view of Auguste, the final Office Action acknowledges that Smith "does not teach the polyamide in the powder form." Final Office Action at 13. The final Office Action relies on Auguste for the sole purpose of attempting to cure this acknowledged deficiency of Smith. However, Auguste does not cure the above-noted deficiencies of Smith with regard to independent claim 1, from which claims 43 and 44 ultimately depend. For at least this reason, the § 103(a) rejection of claims 43 and 44 should be reversed.

The rejection of claims 12, 13, and 61-64 under § 103(a) should be reversed.

With regard to the § 103(a) rejection of claims 12, 13, and 61-64 as being unpatentable over Smith in view of Yoko, the final Office Action acknowledges that Smith "does not teach magnetizable particles in the therapeutic composition." Final Office Action at 15. The Office Action relies on Yoko for the sole purpose of attempting to cure this acknowledged deficiency of Smith. However, Yoko does not cure the

above-noted deficiencies of Smith with regard to independent claim 1, from which claims 12 and 13 ultimately depend, nor does it cure the deficiencies of Smith with regard to independent claim 61, which recites at least one "adhesive matrix." (See the above discussion at pgs. 21-25 explaining how Smith lacks any teaching of an "adhesive material.") For at least these reasons, the § 103(a) rejection of claims 12, 13, and 61-64 should be reversed.

Conclusion


For the reasons given above, the rejections of pending claims 1, 5-30, and 35-68 under the first and second paragraphs of § 112 and under § 103(a) should be reversed.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 21, 2008

By: 

Jeremy T. Thissell
Reg. No. 56,065

Claims Appendix to Appeal Brief Under Rule 41.37(c)(1)(viii)

1. A composite structure for at least one of treating, making up, and cleaning a surface region, the composite structure comprising:

at least two non-adhesive layers, at least one of the two non-adhesive layers being permeable to a solvent and configured to be placed into contact with the surface region; and

at least one adhesive matrix between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in said solvent,

wherein the composite structure is configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region.

5. A composite structure according to claim 1, wherein said solvent comprises water.

6. A composite structure according to claim 1, wherein the matrix contains at least one water-soluble active agent.

7. A composite structure according to claim 1, wherein the matrix comprises at least one moisture-absorbing compound.

8. A composite structure according to claim 1, wherein the adhesive matrix contains 0.2% to 60% by weight of a moisture-absorbing compound.

9. A composite structure according to claim 1, wherein the adhesive matrix includes at least one moisture-absorbing compound chosen from polyacrylates, silicas, cotton fibers, starches, alginates, calcium carbonates, magnesium, viscose, cellulose, and freeze-dried substances.

10. A composite structure according to claim 1, wherein the adhesive matrix comprises at least one substantially inert substance.

11. A composite structure according to claim 1, wherein the active agent is chosen from vitamin C, vitamin A, vitamin F, glycerin, laponite, wetting agents, collagen, salicylic acid, tio acid, caffeine, aromatic essential oils, coloring agents, anti-oxidants, free radical scavengers, moisturizers, depigmenting agents, liporegulators, anti-acne agents, antidandruff agents, anti-aging agents, softeners, antiwrinkle agents, keratolitic agents, anti-inflammatory agents, fresheners, healing agents, vascular protectors, antibacterial agents, antifungal agents, antiperspirants, deodorants, skin conditions, anesthetics, immunomodulators, and nourishing agents.

12. A composite structure according to claim 1, wherein the adhesive matrix includes magnetizable particles.

13. A composite structure according to claim 12, including at least two layers of magnetizable particles capable of generating respective magnetic fields of different polarities.

14. A composite structure according to claim 1, wherein the adhesive matrix comprises a permanent adhesive comprising one of vinyl, PVA, PVP, pseudo-latex, an acrylic polymer, a polyurethane, and a latex elastomer.

15. A composite structure according to claim 1, wherein at least one of the two layers comprises a non-woven fabric.

16. A composite structure according to claim 1, wherein the at least two layers are permeable to the solvent.

17. A composite structure according to claim 16, wherein said at least two layers have at least one of different roughnesses, different porosities, and different thicknesses so as to enable two different types of application to be performed depending on a face of the layer selected by the user for application.

18. A composite structure according to claim 1, including an impermeable layer.

19. A composite structure according to claim 1, wherein the composite structure comprises at least two adhesive matrices of identical compositions, the at least two adhesive matrices being one of juxtaposed and superposed.

20. A composite structure according to claim 19, wherein said at least two adhesive matrices are stuck to each other and include different active agents.

21. A composite structure according to claim 1, comprising a superposition of layers comprising, in order, a first support layer, a first adhesive matrix containing at least one active agent, a second support layer, and a second adhesive matrix essentially covered by a removable protective film.

22. A composite structure according to claim 1, comprising a superposition of layers comprising, in order, a first support layer, a first adhesive matrix containing at least one active agent, a second support layer, a second adhesive matrix containing at least one active agent, and a third support layer, the second support layer being

impermeable and the first and third support layers being permeable, the first and second adhesive matrices containing different active agents.

23. A composite structure according to claim 1, comprising a superposition of layers comprising, in order, a first support layer, a first adhesive matrix, a second adhesive matrix, and a second support layer.

24. A composite structure according to claim 21, wherein the first and second adhesive matrices have respective active agents that need to be stored separately.

25. A composite structure according to claim 1, wherein the adhesive matrix comprises two juxtaposed regions containing different active agents.

26. A composite structure according to claim 25, wherein the adhesive matrix is a first adhesive matrix, and wherein the structure further includes a second adhesive matrix comprising two juxtaposed regions containing different active agents, the active agents contained in the second adhesive matrix being different from those of the adhesive matrix.

27. A method of manufacturing a composite structure for at least one of cleaning, treating, and making up a surface region, the method comprising:

coating a first non-adhesive layer with an adhesive matrix comprising a permanent adhesive, said adhesive matrix containing at least one active agent, the active agent being released when the composite structure is wetted by a solvent; and

assembling together the coated first non-adhesive layer with a second non-adhesive layer such that the adhesive matrix is sandwiched between the first non-adhesive layer and the second non-adhesive layer and such that one of the first and second non-adhesive layers is configured to be placed into contact with the surface

region, the first non-adhesive layer and the second non-adhesive layer being permanently bonded together by the adhesive matrix.

28. A method according to claim 27, further comprising coating the second layer on one face with a second adhesive matrix.

29. A method according to claim 28, wherein the two adhesive matrices are stuck together.

30. A method according to claim 27, wherein a large quantity of layers coated in adhesive matrices containing predetermined active agents are manufactured separately, and wherein the various layers coated in this way are assembled together to make up a range of composite structures presenting different combinations of active agents.

35. A pile of composite structures, comprising at least two composite structures as defined in claim 1, one of the two layers of each composite structure having an adhesive face in contact with an underlying composite structure and having an extension enabling the pile of composite structures to be taken hold of by a user.

36. A composite structure according to claim 1, wherein the adhesive matrix contains at least one additional active agent configured to swell when contacted by the solvent, the adhesive matrix containing a sufficient quantity of the at least one additional active agent such that the adhesive matrix loses cohesion on contact with the solvent and releases the additional active agent more easily.

37. A composite structure according to claim 1, wherein the adhesive matrix contains at least one additional active agent soluble in the solvent, the adhesive matrix containing a sufficient quantity of the at least one additional active agent such that the

adhesive matrix loses cohesion on contact with the solvent and releases the additional active agent more easily.

38. A composite structure according to claim 1, wherein the adhesive matrix contains at least one additional active agent soluble in the solvent and configured to swell when contacted by the solvent, the adhesive matrix containing a sufficient quantity of the at least one additional active agent such that the adhesive matrix loses cohesion on contact with the solvent and releases the active agent more easily.

39. A composite structure according to claim 1, wherein the at least one active agent is configured to swell when contacted by the solvent, the adhesive matrix containing a sufficient quantity of the at least one additional active agent such that the adhesive matrix loses cohesion on contact with the solvent and releases the active agent more easily.

40. A composite structure according to claim 1, wherein the adhesive matrix contains a filler comprising at least one compound configured to swell on contact with the solvent, the adhesive matrix containing a sufficient quantity of the at least one compound such that the matrix loses its cohesion on contact with the solvent and releases the active agent more easily.

41. A composite structure according to claim 1, wherein the adhesive matrix contains a filler comprising at least one substantially inert compound, the adhesive matrix containing a sufficient quantity of the at least one compound such that the matrix loses its cohesion on contact with the solvent and releases the active agent more easily.

42. A composite structure according to claim 8, wherein the adhesive matrix contains 0.5% to 40% by weight of the moisture-absorbing compound.

43. A composite structure according to claim 10, wherein the at least one substantially inert substance comprises one of microbeads of an inert compound and powder of an inert compound.

44. A composite structure according to claim 43, wherein the powder of an inert compound comprises a polyamide powder.

45. A composite structure according to claim 1, wherein the composite structure comprises at least two adhesive matrices of at least two different compositions, the at least two adhesive matrices being one of juxtaposed and superposed.

46. A composite structure according to claim 45, wherein said at least two adhesive matrices are stuck to each other and include different active agents.

47. A method of applying a patch to skin, comprising:
applying a patch to the skin for a predetermined length of time, wherein the patch comprises the composite structure as defined in claim 1.

48. A method of cleaning skin, comprising:
contacting the skin with the composite structure as defined in claim 1.

49. A method of treating hair, comprising:
contacting the hair with the composite structure as defined in claim 1.

50. A composite structure according to claim 1, wherein the adhesive matrix comprises an active agent reservoir, and wherein the composite structure may be re-wetted at least once.

51. A composite structure according to claim 1, wherein the at least one adhesive matrix comprises a single layer of adhesive matrix.

52. A composite structure according to claim 51, wherein the single layer contacts the at least two non-adhesive layers.

53. A composite structure according to claim 51, wherein a second layer of adhesive matrix contacts one of the at least two non-adhesive layers.

54. A composite structure for at least one of treating, making up, and cleaning a surface region, the composite structure comprising:

at least two non-adhesive layers, at least one of the two non-adhesive layers being permeable to a solvent; and

at least one adhesive matrix between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in said solvent,

wherein the composite structure is configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region, and

wherein the structure is configured such that the adhesive matrix does not come into contact with the surface region.

55. A composite structure for at least one of treating, making up, and cleaning a surface region, the composite structure comprising:

at least two non-adhesive layers, at least one of the two non-adhesive layers being permeable to a solvent; and

at least one adhesive matrix between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being

permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in said solvent,

wherein the composite structure is configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region, and

wherein the composite structure does not adhere to the surface region before being wetted by the solvent.

56. A composite structure for at least one of treating, making up, and cleaning a surface region of the human body, the composite structure comprising:

at least two support layers, at least one of the two support layers being permeable to a solvent, said support layers forming external faces of the structure; and

at least one adhesive matrix between the two support layers, the two support layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in said solvent,

wherein the composite structure is configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region.

57. A composite structure according to claim 56, wherein the adhesive matrix is in contact with said two support layers.

58. A composite structure according to claim 56, comprising two adhesive matrices stuck together and sandwiched between the two support layers.

59. A composite structure according to claim 56, wherein the composite structure is configured to be capable of adhering to the surface region of the human body.

60. A composite structure according to claim 56, wherein the solvent comprises water.

61. A composite structure for at least one of treating, making up, and cleaning a surface region of the human body, the composite structure comprising:

at least two support layers; and

at least one adhesive matrix between the two support layers, the two support layers being permanently bonded to the adhesive matrix, said adhesive matrix further comprising magnetizable particles.

62. A composite structure according to claim 61, wherein at least one of the two support layers is permeable to a solvent.

63. A composite structure according to claim 62, wherein the adhesive matrix contains at least one active agent that is soluble in said solvent.

64. A composite structure according to claim 63, wherein the composite structure is configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region.

65. A composite structure according to claim 1, wherein the composite structure is configured to treat an exterior body surface with the active agent.

66. A composite structure according to claim 1, wherein the composite structure has a substantially constant thickness.

67. A method according to claim 28, wherein the composite structure has a substantially constant thickness.

68. A composite structure for at least one of treating, making up, and cleaning a surface region of the human body, the composite structure comprising:

at least two support layers; and

at least one adhesive matrix between the two support layers, the two support layers being permanently bonded to the adhesive matrix;

wherein the composite structure has a substantially constant thickness.

Evidence Appendix to Appeal Brief Under Rule 41.37(c)(1)(ix)

None.

Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x)

Appellant attaches a copy of a Decision on Appeal, mailed on May 2, 2008, in Application No. 10/107,410 (Appeal 2008-0002).



UNITED STATES PATENT AND TRADEMARK OFFICE

08048-0028
TLI/AMG/JTT
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/107,410

03/28/2002

Jean-Louis H. Gueret

08048.0028-00

1601

22852

7590

05/02/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

SILVERMAN, ERIC E

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

05/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

RECEIVED
MAY 05 2008
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP

Att. of Allowance Pending
PTOL-90A (Rev. 04/07)

©
S/S/00

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-LOUIS H. GUERET

Appeal 2008-0002
Application 10/107,410
Technology Center 1600

Decided: May 1, 2008

Before TONI R. SCHEINER, LORA M. GREEN, and
RICHARD M. LEOVITZ, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal¹ under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-63. We have jurisdiction under 35 U.S.C. § 6(b). Claim 1, 45, 60, and 61 are the independent claims on appeal, and read as follows:

¹ This Appeal was heard on April 17, 2008.

1. A treatment device, comprising:
a cover defining a cavity, the cavity being configured to receive a part of a body, the cover comprising
at least one sheet having a composite structure, the composite structure comprising
at least two layers, at least one of the two layers being permeable to a solvent, and
at least one adhesive matrix situated between the two layers, the two layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in the solvent,
wherein, when the active agent is dissolved in the solvent, the active agent is released from at least one side of the cover, and
wherein the device is configured so that the active agent is released into the cavity.

45. A method of manufacturing a device for treating a part of the body, the method comprising: providing at least one sheet comprising a composite structure of at least one adhesive matrix between at least two layers, at least one of the two layers being permeable to a solvent, the two layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent soluble in the solvent, the at least one active agent being released through at least one side of the sheet when dissolved; and
at least one of folding the at least one sheet over onto itself, shaping the at least one sheet into a bag, and assembling the at least one sheet with at least one other sheet, so as to form a cover defining a cavity in which a part of a body may be received.

60. A treatment device, comprising:
a cover defining a cavity, the cavity being configured to receive a part of a body; the cover comprising
at least one sheet having a composite structure, the composite structure comprising
at least two layers, at least one of the two layers being permeable to a solvent, wherein at least one of two layers is at least partially impermeable, and
at least one adhesive matrix situated between the two layers, the two layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in the solvent,

wherein, when the active agent is dissolved in the solvent, the active agent is released from at least one side of the cover, and

wherein the adhesive matrix is between the at least partially impermeable layer and the cavity.

61. A treatment device, comprising:

a cover defining a cavity, the cavity being configured to receive a part of a body, the cover comprising

at least one sheet having a composite structure, the composite structure comprising

a first layer and a second layer, the first layer and second layer being permeable to a solvent, and

a first adhesive matrix situated between the first layer and the second layer, the first layer being permanently bonded to the first adhesive matrix, the first adhesive matrix containing at least a first active agent that is soluble in the solvent,

a second adhesive matrix situated between the first layer and the second layer, the second adhesive layer being permanently bonded to the first adhesive matrix and the second layer, the second adhesive matrix containing at least a second active agent that is soluble in the solvent,

wherein the cover is configured such that when the first active agent is dissolved in the solvent, the first active agent is released through the first layer and, when the second active agent is dissolved in the solvent, the second active agent is released through the second layer.

The Examiner relies upon the following references:

Shlenker	5,965,276	Oct. 12, 1999
Gueret	5,026,552	Jun. 25, 1991
JEX CO LTD (translation)	JP 54-22300	Sept. 13, 1979

We reverse.

DISCUSSION

Claims 1, 2, 4, 7-9, 14, 15, 19, 22-25, 27, 31-35, 37-55, 58, 59, 62, and 63 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Shlenker.

Shlenker is cited for teaching a glove that is made of single or multiple layers or membranes, some or all of which are permeable or semi-permeable, as well as also having an intermediate layer, constructed in a manner that is triggered to release an active agent from the inner layer (Ans. 3). Shlenker is also cited for teaching an inner needle treatment layer that includes an adhesive (*id.*).

It is well settled that to anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001).

Appellant argues that Shlenker “fails to disclose or suggest, . . . at least one ‘adhesive matrix containing at least one active agent that is soluble in the solvent, wherein, when the active agent is dissolved in the solvent, the active agent is released from at least one side of the cover.’” (App. Br. 14.) Appellant argues further that Schlenker “does not disclose or necessarily require that ‘when the active agent is dissolved in the solvent, the active agent is released from at least one side of the cover,’” and also does not disclose “‘at least one active agent being released through at least one side of the sheet when dissolved,’ as recited in claim 45.” (*Id.* at 15.) According to Appellants, Schlenker discloses other triggers for the release of active agent, such as mechanical shearing or puncture (*id.*).

The Examiner responds that Shlenker “clearly discloses an inner needle-treatment layer, which, at least in one embodiment, is a gummy coating, which is disclosed to be an adhesive (col. 4, ll. 53-58).” (Ans. 8.) Thus, according to the Examiner, Shlenker “does disclose an adhesive matrix situated between the two layers, wherein the two layers are bound to the adhesive matrix.” (*Id.*)

We find that Appellant has the better argument. We agree with the Examiner that Shlenker teaches the use of an adhesive containing an active agent as an intermediate layer. But that teaching is in the context of a needle treating layer, and there is no teaching or suggestion in Shlenker that such an intermediate layer is sandwiched between two layers, wherein at least one of the two layers is permeable to a solvent.

Specifically, Shlenker teaches that the “needle or sharp object treating layer comprises a gummy coating such as . . . an adhesive, . . . with or without an admixed biocide, antiseptic, or sterilizing agent, as an inner layer.” (Shlenker, col. 4, ll. 53-58.) According to Shlenker, as “the needle or other object pierces the membrane, the treatment substance tends to stick to it, coat it, cleanse it, or otherwise deactivate any harmful substances which might adhere thereto.” (Col. 4, ll. 59-62.) Thus, in the embodiment of Shlenker relied upon by the Examiner for the adhesive, it is not the permeability or semi-permeability of one of the layers that allows for deployment of the active agent, but rather, it is a mechanical piercing by a sharp object such as a needle. That is supported by Shlenker, who further teaches that as “an alternative to permeability, substantially impermeable layers may transmit the substance or agent upon rupture or piercing and completely contain the substances at all other times.” (Col. 2, ll. 5-8.)

Therefore, while Shlenker teaches an article having at least one semipermeable outer layer, as well as an article having an adhesive layer inner layer containing an active agent, the Examiner does not point to, nor can we find, a teaching or suggestion in Shlenker of an article that has both at the same time. Thus, Shlenker does not teach all of the limitations of the independent claims, and we are compelled to reverse the rejection.

Claims 3, 5, 6, 26, 29, 30, 36, and 56-61 stand rejected under 35 U.S.C. § 103(a) as being obvious over Shlenker.

The obviousness rejection over Shlenker is written to cover additional limitations of the dependent claims, such as using any shape that is suitable to the use, such as a bag or mitten, or incorporating polyamide power (Ans. 4-5.) Thus, the rejection does not overcome the deficiencies of the anticipation rejection over Shlenker, and the rejection is reversed.

Claims 10-13, 16-21, and 28 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Shlenker as combined with Gueret.

Shlenker is relied upon as for the anticipation rejection (Ans. 5). Gueret is relied upon for its teaching of separating agents (*id.* at 6). Thus, Gueret does not remedy the deficiencies of Shlenker, and the rejection is reversed.

Claims 29, 30, and 36 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Shlenker and JEX.

Shlenker is relied upon as for the anticipation rejection (Ans. 6). JEX is relied upon for its teaching the use of a non-woven fabric layer (*id.* at 6-7). Thus, JEX does not remedy the deficiencies of Shlenker, and the rejection is reversed.

CONCLUSION

In summary, the rejections on appeal are reversed.

REVERSED

lp

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413